- - REMARKS - -

Claims 1-9 and 11-27 remain under consideration. Claims 13-22 have been amended to improve their form and not to avoid any reference.

The Drawings were objected to

The objection to the drawings is traversed. The Examiner failed to identify a single limitation of the claims that is not shown in the drawings. While the Applicants thank the Examiner for the citation to MPEP 608.02(d) and the reminder that any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. Applicants note that each structural detail that is essential for a proper understanding of the disclosed invention is shown in the drawings.

Applicants also express confusion over the Examiner's objections to the drawings, as the Examiner's cover sheet indicates that the drawings are acceptable.

Withdrawal of the objection to the drawings is requested.

Claims 1, 13, and 23 were rejected under §112 ¶1 as failing to comply with the enablement requirement.

The §112 ¶1 rejection of claims 1, 13, and 23 is traversed.

The enablement requirement refers to the requirement of 35 U.S.C. 112, first paragraph that the specification describe how to make and how to use the invention. The invention that one skilled in the art must be enabled to make and use is that defined by the claim(s) of the particular application or patent. See, MPEP §2164.

The enablement requirement of 35 U.S.C. 112, first paragraph, is separate and distinct from the description requirement. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) ("the purpose of the 'written description' requirement is broader than to merely explain how to 'make and use'"). See also MPEP § 2161. Therefore, the fact that an additional limitation to a claim may lack descriptive support in the disclosure as originally filed does not necessarily mean that the limitation is also not enabled. In other words, the statement of a new limitation in and of itself may enable one

skilled in the art to make and use the claim containing that limitation even though that limitation may not be described in the original disclosure. Consequently, such limitations must be analyzed for both enablement and description using their separate and distinct criteria. See, MPEP §2164.

Here, the Examiner appears to argue that one of ordinary skill in the art cannot practice the invention without undue diligence based on a preamble recitation that the target devices are persistently and concurrently in communication with the server by means of a network. This assertion is made without any evidence, and without even stating a prima facie case of lack of enablement.

First, a prima facie case of lack of enablement is premised on those of ordinary skill in the art, and whether such a person would find that the experimentation needed to practice the invention undue or unreasonable. Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and Lindemann *Maschinenfabrik*

GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). Determining enablement is a question of law based on underlying factual findings. *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984).

Here, the Examiner fails to even *allege* that undue experimentation is necessary. The Examiner solely alleges that the term "concurrently and persistently unable to locate within the specification" (sic). While Applicants are confident that the Examiner intended to allege that the term "concurrently and persistently" does not appear in the specification, such an allegation, be it true or false, is irrelevant to enablement under §112 ¶1. Enablement under §112 ¶1 is concerned with the level of experimentation that would be required by one of ordinary skill in the art. Here, the level of experimentation required is minimal, as those of skill in the networking arts are well familiar with target devices [that] are persistently and concurrently in communication with [a] server by means of a network. Should the Examiner intend to seriously contend that those of skill in the networking arts do not understand this limitation or would require undue experimentation to understand this limitation, Applicants gently demand that the Examiner provide evidence of the level of skill in the art.

Withdrawal of the rejection to claims 1, 13, and 23 is requested.

Claim 13 was rejected under 35 U.S.C.§101

The §101 rejection of claim 13 has been obviated by amending the claim to recite a computer readable medium including computer readable code. The claims depending from claim 13 have been amended to recite a medium, rather than a program.

Withdrawal of the rejection to claim 13 is requested.

The Examiner rejected claims 1-9 and 11-27 as unpatentable under 35 U.S.C. §103(a) by Beelitz in view of Cohn

The §103(a) rejection of claims 1-9 and 11-27 is traversed. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, MPEP §2143.

There is no motivation to combine the references

Beelitz in view of Cohn does not teach or suggest, inter alia, wherein the target devices are persistently and concurrently in communication with the server by means of a network as claimed in claims 1, 13 and 23. The mere fact that references can be combined is not sufficient to establish obviousness under 35 U.S.C. §103(a). In re Mills, 916 F.2d 680 (Fed. Cir. 1990), MPEP §2143.01.

Beelitz unequivocally teaches away from these claims – there is no rational basis for the Examiner to assert that one of ordinary skill in the art would be motivated to modify Beelitz as suggested by the Examiner. Thus, any combination of a reference with Beelitz cannot support a rejection under §103(a). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

Beelitz teaches generation of a compatible order for a computer system, whereas Cohn teaches a network based multimedia communication and directory system and method of operation. Beelitz is addressed to a problem facing computer manufacturers – how to install a desired operating system on a target computer that is the subject of a pending sale of the target computer. "A system for specifying, ordering, and building a build-to-order computer system." Abstract, Beelitz. Therefore, for Beelitz, having the target devices persistently and concurrently in communication with a server by means of a network would be pointless. Most purchasers of computers do not purchase the computer to sit on the assembly line – the computers are purchased to be delivered to the purchasing customer. Keeping the computer persistently and concurrently attached to the server would not be in line with the expectations of a customer.

In contrast, the instant invention, directed at computer networks wherein the target devices [are] persistently and concurrently in communication with [a] server by means of a network would solve a problem facing the inventors. Namely, the claimed invention illustrates how to generate a list of target devices to be configured in communication with a server.

Modification of Beelitz as suggested by the Examiner would destroy the principle of operation of Beelitz, and therefore the §103(a) rejection is improper. Even if Beelitz were so modified as to generate a list target devices, such a list would immediately be irrelevant upon shipping any of the target devices to their purchaser – hardly a desirable result.

In addition, there can further be no motivation to combine the references because the Examiner cannot conclusively assert that the addition of a network as taught by Cohn would assist in the generation of a compatible order for a build-to-order computer system as taught by Beelitz. See, column 1, lines 32-34 of Beelitz. This is true both because Beelitz fails to assert that its method of generating a compatible order for a computer system is suboptimal, and Cohn fails to assert that its network is optimal.

The Examiner asserts that Beelitz "does not explicitly go into the detail of persistently and concurrently in communication." While true, the Examiner's point actually supports Applicants' position. Beelitz does not "explicitly" go into such detail, precisely because such explicit detail would destroy the function of Beelitz – in the event that the target devices of Beelitz were persistently and concurrently in communication with the server, such an outcome would result in the target devices persisting on the assembly line and failing to be delivered to the customer. While such an outcome may be tenable for an exceptionally short period of time, customer complaints of non-delivery would soon overwhelm any customer service facilities, and the inventory of target devices would soon overwhelm any storage facility.

Withdrawal of the rejections to claims 1-9 and 11-27 is requested for at least these reasons.

The references do not teach or suggest each claim limitation

Even despite the lack of a motivation to combine the references, the references, alone or in combination, fail to teach or suggest each claim limitation.

Specifically, claim 27 requires creating a router list of target devices, comparing the router list and the first list of target devices, and wherein modifying the first list of target devices using the addressed target device comprises modifying the first list of target devices based on the comparison. The Examiner correctly does not cite to Cohn for any such teaching, and rather relies on Beelitz. However, Beelitz makes no such teaching.

At most, Beelitz teaches that a list of hard drive preparation operations and a list of patches is generated by control. See, column 10, lines 10-52 and column 16 lines 4-10 (as cited by the Examiner). Beelitz does not teach or suggest creation of a router list, nor comparing the router list to the first list of target devices. Additionally, Beelitz does not teach or suggest modifying the first list of target devices based on the comparison. Since Cohn does not cure this defect, the Examiner cannot conclusively assert that the references alone or in combination teach each claim limitation.

Withdrawal of the rejections to claim 27 is requested for at least this additional reason.

CONCLUSION

The Applicants respectfully submit that claims 1-9 and 11-27 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

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Respectfully submitted,
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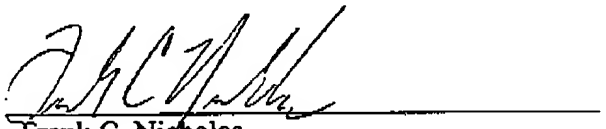

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